

REMARKS

Claims **70-79 and 81-91** are pending.

Claims **70-79 and 81-91** have been rejected.

We hereby respectfully traverse all of the rejections, as the pending claims are patentably distinct from the cited art. In view of the comments that follow, the Applicants respectfully request that the Examiner reconsider and withdraw all of the Section 103(a) rejections.

We note that the Examiner has reopened prosecution of this application, and that all of the obviousness rejections based on U.S. Patent No. 5,909,673 issued to Gregory in view of U.S. Patent No. 5,377,271 issued to Foreman et al. have been withdrawn.

New Section 103(a) Rejections

All of the pending claims (Claims **70-79 and 81-91**) have been rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over U.S. Patent No. 5,684,291 issued to Taskett (“Taskett”).

Taskett pertains to the field of prepaid transaction instruments that can be used by a purchaser upon purchase and activation. Taskett purportedly solves the problems of securely providing such prepaid instruments and preventing fraudulent activity by a merchant or other persons in the distribution chain (See Col. 1, lines 17-65 and Col. 2, lines 50-55). Described are systems and methods for securely issuing prepaid telephone cards that include both an identification code for use by the purchaser to gain access to a prepaid telephone account, and a replacement code related to the identification code according to a secret relationship maintained by the issuer of the transaction instrument. The replacement code may be printed on a separate and distinct document from the identification code, or on the same document on a separable portion thereof. If the prepaid instrument is lost or stolen, the issuer can issue a replacement if the purchaser provides the replacement code (See Taskett, Abstract and Col. 1, lines 5-13). Such a scheme permits the issuer of prepaid instruments to securely provide a credit, replacement, or reimbursement to a purchaser of a lost or stolen prepaid instrument (see Col. 2, lines 60-64). In summary, a purchaser of Taskett’s prepaid transaction instruments obtains both an identification code and a related replacement code, wherein the codes have a relationship to each other which will enable the purchaser to obtain a replacement or refund from the issuer if the prepaid instrument is lost or stolen.

In contrast, the pending independent claims recite methods and systems for issuing a gift certificate corresponding to, or drawn on, a financial account. The gift certificate includes only a certificate identifier and does not include an account identifier and does not include a “replacement code”. The certificate identifier corresponds to the account identifier, which is associated with a financial account, but the certificate identifier is different from the account identifier. The gift certificate may be distributed to an owner of a financial account, or to some other recipient. Pending independent claim **70** is illustrative:

70. A method for issuing a gift certificate corresponding to a financial account, comprising the steps of:
generating, by a computer, a certificate identifier
corresponding to an account identifier that is associated with a financial account, said certificate identifier being different from said account identifier;
producing a gift certificate including thereon said certificate identifier,
said gift certificate not including said account identifier;
and
distributing said gift certificate to an owner of said financial account.

The Examiner has erroneously equated portions of the disclosure of Taskett to the pending independent claims. We assert that Taskett fails to teach or suggest issuing a gift certificate that corresponds to a financial account, wherein the gift certificate includes a certificate identifier that corresponds to an account identifier associated with the financial account. In particular, the portions cited by the Examiner in Taskett, at Col. 3, lines 1-21 and Col. 5, lines 36-49 pertain to the embodiment of a prepaid calling card shown in Figs. 1A to 1C. In this embodiment, a sealed envelope 102 having a tracking number printed on the outside contains the prepaid calling card 104 and a separate replacement document 106 (see Fig. 1A). The prepaid card 102 contains a service network telephone number, an ID code, and instructions for dialing (see Fig. 1B, and Col. 3, lines 1-9). The replacement card 106 includes a replacement code and a telephone number (see Fig. 1C, and Col. 3, lines 10-20). The purchaser of the prepaid calling card first dials the service network telephone number, and then enters the ID code upon a prompt before being permitted to enter a desired telephone number (see Col. 4, lines 49-67). Fig. 2 of Taskett was also cited for the

same proposition, but this embodiment comprises a receipt 202 that could be printed by an ATM or POS terminal, wherein the receipt includes both an authorization code and a replacement code separated by a dotted line 203 (see Col. 6, line 53 to Col. 7, line 9). Neither of the authorization code or the replacement code corresponds to an account identifier associated with a financial account. We therefore submit that Taskett does not teach or suggest a gift certificate that includes a certificate identifier that corresponds to an account identifier associated with a financial account.

Furthermore, the pending independent claims **70, 76, 78, and 81** concern distributing the gift certificate to an owner of the financial account, which is not taught or suggested by Taskett. We note that the cited portions of Taskett at Col. 3, lines 38-35(*sic.* 45) and Col. 4, lines 35-48 have nothing whatsoever to do with such a process. In particular, the passage at Col. 3, lines 38-45 recites that a third identifier, a tracking number related to one or both of the ID code and/or the replacement code of the prepaid telephone card, may be placed on the outside of the sealed envelope or in a manner otherwise readable by the merchant to enable the merchant to activate an account at the time of purchase. The passage at Col. 4, lines 35-48 is equally irrelevant, as this passage contains observations that the prepaid telephone card 104 includes information necessary to allow a purchaser to draw upon the prepaid account, wherein the prepaid account corresponds to a prepaid long distance telephone account, and that other prepaid arrangements affected through the same type of scheme may be used. Neither of these cited passages therefore discloses distributing the prepaid calling card to an owner of the financial account. We note that the Examiner attempted to again address this issue with regard to pending claim **81** on page 4 of the Office Action, but the citation is incomplete as it fails to include a column number (it reads: “(col. __, lines 33-65)”). However, we checked lines 33-65 of each of columns 1 through 10 of Taskett and could not find any disclosure concerning distributing a prepaid transaction instrument to an owner of the financial account. Consequently, we submit that claims **70, 76, 78 and 81** are patentably distinct from Taskett.

Yet further, as admitted on page 4 of the Office Action, Taskett fails to suggest or teach a sixteen-digit identifier that is an alias of an account identifier that identifies a financial account, as recited by claim **81**. We additionally submit that Taskett fails to suggest or teach to produce a gift certificate with a certificate identifier that is an alias of an account identifier or financial account or credit card account, as recited by independent claims

81, 83 and 91. With regard to this issue, we disagree with and question the Examiner's statement that:

"It would have been obvious to one having ordinary skill in the art... to have the gift certificate to include a sixteen-digit identifier as a design choice, in which the sixteen-digit certificate is an alias of an account identifier that identifies a financial account and to modify in Taskett because such a modification would allow Taskett to have a special program generated security numerical indicia defined by a printed character on an unprinted background." (Office Action, paragraph bridging pages 4 to 5)

The statement quoted above is incoherent. We also submit that no support can be found in Taskett for the proposition that any of the modifications that are apparently being suggested would have been obvious to one of ordinary skill in the art. In particular, Taskett does not teach or suggest providing an alias for any identification number, and Taskett does not mention any such "special program generated security numerical indicia", whatever that may mean. Furthermore, we cannot understand the allusion to "a printed character on an unprinted background", or how this relates to the pending claims. The Examiner has apparently manufactured these notions in an attempt to buttress the obviousness rejections of these claims. Therefore, if this rejection is to be maintained, we request clarification of the statement quoted above and citations to one or more references in support in the next correspondence mailed by the Office. In the absence of clarification and support for these assertions, we maintain our assertion that independent claims **81, 83 and 91** are patentably distinct over Taskett.

We also note that, on page 5 of the Office Action with regard to independent claims **83 and 91**, the Examiner admits that Taskett fails to suggest or teach generating an alias identifier that provides an indirect link to the financial account. However, the Examiner states:

"...However, it would have been obvious to one having ordinary skill in the art... to generate an alias identifier that provides an indirect link to the financial account, in which the alias identifier is different from the account identifier; and to modify Taskett because such a modification would allow Taskett to have a predetermined number sequence corresponding to the serial number of a particular money order form (gift certificate) which is considered and alias identifier." (see Office Action, page 5, second full paragraph.)

We assert that this statement is wholly unsupported, as Taskett does not teach or suggest providing a "number sequence" and prepaid calling cards have nothing to do with money order forms. There is nothing in

Taskett to suggest that the prepaid transaction instruments should include “sequence numbers”, and we do not understand what the Examiner is alluding to by this statement. We thus reassert that claims **83 and 91** are patentably distinct over Taskett.

In summary, Taskett does not teach or suggest producing a gift certificate that includes a certificate identifier corresponding to an account identifier that is associated with a financial account and that is different from the account identifier, and wherein the gift certificate does not include the account identifier as recited by independent claims **70, 73, 76, 77, 78 and 79**. In addition, Taskett fails to teach to produce a gift certificate with a certificate identifier that is an alias of an account identifier or financial account or credit card account, as recited by independent claims **81, 83 and 91**. Moreover, Taskett fails to suggest or teach to distribute the gift certificate to the owner of the financial account, as recited by independent claims **70, 76, 78 and 81**. Thus, we submit that these claims are patentably distinct over Taskett.

Since claims **71, 72, 74, 75, 82 and 84-90** each depend on one of independent claims **70, 73, 76, 77, 78, 79, 81, and 83**, these dependent claims should be allowable for at least the same reasons set forth above.

Accordingly, the Applicants respectfully request withdrawal of all of the Section 103(a) rejections and allowance of the present application.

The prior art made of record and not relied upon have not been discussed herein as none of those references were applied to the pending claims.

Conclusion

In view of the above remarks, the Applicants respectfully submit that all of the claims are in condition for allowance, early notice of which would be appreciated. If the Examiner has any questions or does not agree that all pending claims are allowable, the Examiner is cordially requested to contact Stephan Filipek at telephone number (203) 461-7252 or via electronic mail at sfilipek@walkerdigital.com.

We do not believe that any other fees are due, as this Response is being filed within three months of the mailing date of the Office Action. But if a fee should be necessary to continue prosecution of the present application, please charge any such required fee to our Deposit Account No. 50-0271, Order No. 96-140-C1. In addition, please credit any overpayment to Deposit Account No. 50-0271.

Respectfully submitted,

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Date

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